

Nalco Docket No.: 7780-NES

**OFFICIAL****REMARKS**

This is in reply to the Office Action mailed on November 25, 2005 ("Office Action").

Claims 1-28 are currently pending.

Claims 1-28 are subject to an election/restriction requirement under 35 U.S.C. § 121.

Certain foreign-language references contained in Applicants Information Disclosure filed on March 8, 2005 were not considered as they were not accompanied by a concise explanation of their relevance.

The Examiner has requested a new oath or declaration.

The Abstract is objected to because it refers to (a) and (b) without defining them.

Claims 19-20 and 27-28 are objected to.

Claims 3 and 8-9 are rejected under 35 U.S.C. § 112, second paragraph.

Claims 1-4, 7-10, 12-15, 17-19 and 21 are rejected under 35 U.S.C. § 103(a) over U.S. Patent 3,740,367 ("Winkelblech").

Claims 1-12, 14-15 and 17-28 are rejected under 35 U.S.C. § 103(a) over WO 03/014170 ("Baloche").

Claim 16 is allowable if rewritten to overcome the rejections under 35 U.S.C. § 112, second paragraph and to include all of the limitations of the base claim and any intervening claims.

The specification is amended to provide a new Abstract.

Claims 1, 4-8, 13-16 and 27-28 are amended to particularly point out and distinctly claim subject matter which Applicant regards as the invention.

No new matter is added by this amendment.

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**OFFICIAL****DISCUSSION****The Election of Species under 35 U.S.C. § 121**

The Examiner has required Applicant to elect a single unsaturated monomer (c) for prosecution on the merits.

In a telephone conversation with the Examiner on November 10, 2005, applicant elected the unsaturated monomer vinyl acetate with traverse.

Applicant hereby affirms this election.

**The Information Disclosure Statement**

The Examiner has placed certain foreign language references listed in Applicants IDS/Form 1449 in the file without consideration as Applicant did not provide a concise explanation of their relevance.

Applicant respectfully asserts that English language abstracts have been submitted for all of the foreign patent documents. Applicant further respectfully asserts that it is the English language abstracts that comprise the IDS, hence the foreign language documents themselves were not submitted. Applicant respectfully asserts that the relevance of the Abstracts can be readily determined.

**The Oath/Declaration**

The Examiner states that the oath or declaration is defective for failure to identify the application by application number and filing date and failure to provide a mailing address.

Applicant respectfully asserts that the DECLARATION FOR PATENT APPLICATION submitted concurrently with the application fully complies with 37 C.F.R. § 1.63 because it contains the title of the application, the inventors name, a reference to the attached specification and the attorney's docket number. MPEP § 602 VI (A)-(C). The document further contains the Inventor's mailing address (5807 Belrose, Houston, Texas 77035). Accordingly, Applicant respectfully requests withdrawal of the Examiner's request for a new oath or declaration.

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**OFFICIAL**The Objection to Claims 19-20 and 27-28

The Examiner objects to claims 19-20 and 27-28, on the basis that the meaning of “polymer actives” is unclear.

Applicant respectfully traverses this rejection.

Applicant respectfully asserts that “polymer actives” is a term commonly used in the art to quantify the amount of polymer in a composition or used in a treatment by stating that the amount polymer is based on the polymer itself, i.e. the polymer actives, as opposed being based on the weight of polymer dispersion, solution, etc. used to make up the polymer composition or applied as a treatment.

Applicant has also amended claims 27 and 28 to recite a method in which oil is treated with 1-5,000 or 10-300 ppm, respectively of polymer. Therefore, claims 19 and 20 recite amounts of polymer contained in the organic solvent based composition of claim 17 while claims 27 and 28 recite amounts of polymer which can be used to treat crude oil. Accordingly, Applicant respectfully asserts that the meaning of claims 19-20 and 27-28 is clear and respectfully requests withdrawal of the objection to the claims.

The Rejection of Claims 3 and 8-9 under 35 U.S.C. § 112, Second Paragraph

Claims 3 and 8-9 are rejected under 35 U.S.C. § 112, second paragraph, in particular for lack of antecedent basis for “olefinic monomer”. Applicant has amended claim 1 to replace “olefinic” with “unsaturated” in reference to monomer (c). Support for this amendment is found in the specification at page 2, line 16. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 3 and 8-9 under 35 U.S.C. § 112, second paragraph.

The Rejection of Claims 1-4, 7-10, 12-15, 17-19 and 21 under 35 U.S.C. § 103(a) over U.S. Patent 3,740,367

Claims 1-4, 7-10, 12-15, 17-19 and 21 are rejected under 35 U.S.C. § 103(a) over U.S. Patent 3,740,367 (“Winkelblech”).

Applicant respectfully traverses this rejection.

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Applicant respectfully asserts that this invention is a paraffin inhibitor composed of (a) 1-98 weight percent of C<sub>1</sub>-C<sub>30</sub> alkyl esters of acrylic acid, (b) 1-98 weight percent of C<sub>1</sub>-C<sub>30</sub> alkyl esters of methacrylic acid and (c) 1-30 weight percent of an unsaturated monomer including vinyl acetate where at least one of the alkyl esters of (a) and (b) must contain six-thirty carbon atoms.

In contrast, Winkelblech discloses a polymer composed of (a) 20-99 weight percent of methyl methacrylate, (b) 0-75 weight percent of alkyl acrylates having 4 to 16 carbon atoms, (c) 0-40 weight percent of ethylenically unsaturated monomers including vinyl acetate and (d) 1-8 percent by weight of acrylic or methacrylic acid or 4-8 weight percent of maleic or itaconic acid for use in paints, lacquers and enamels.

Based on the foregoing, Applicant respectfully asserts that the Examiner's rejection under Section 103(a) is based on a combination of hindsight reconstruction based on Applicant's specification and sheer speculation.

More particularly, Applicant respectfully asserts that Winkelblech, which concerns methyl methacrylate-acid copolymers which may contain certain additional monomer units (components (b) and (c) above) does not teach or suggest a polymer which can contain esters of methacrylic acid other than methyl methacrylate, which must contain alkyl esters of acrylic acid where either the alkylate or methacrylate ester must contain 6-30 carbon atoms and which must contain an additional unsaturated monomer unit which does not contain carboxylic acid units.

Moreover, Applicant respectfully asserts that one of skill in the art would not be motivated to rely on the teachings Winkelblech, which concerns an unrelated field and which discloses a polymer composed in part of methacrylic acid, acrylic acid, maleic acid or itaconic acid and substitute the claimed esters of both acrylic acid and methacrylic acid (but not maleic acid or itaconic acid) in the claimed proportions to arrive at the claimed composition. Applicant respectfully asserts that esters cannot be considered equivalents of acids simply because such esters might hydrolyze to an unknown extent to the corresponding acids under certain conditions. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1-4, 7-10, 12-15, 17-19 and 21 under 35 U.S.C. § 103(a) over U.S. Patent 3,740,367 Winkelblech.

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**OFFICIAL**The Rejection of Claims 1-12, 14-15 and 17-28 under 35 U.S.C. § 103(a) over WO 03/014170

Claims 1-12, 14-15 and 17-28 are rejected under 35 U.S.C. § 103(a) over WO 03/014170, ("Baloche").

Applicant respectfully traverses this rejection.

As is the case with Winkelblech, Applicant respectfully asserts that the rejection over Baloche is based on hindsight reconstruction. More particularly, Applicant respectfully asserts that nothing in Baroche teaches or suggests picking from among the monomers of types A-D disclosed therein to arrive at a terpolymer which must be composed of certain unsaturated monomers, alkyl esters of methyl acrylate and alkyl esters of acrylic acid in the claimed amounts and where one or both of the alkyl esters must contain 6-30 carbon atoms.

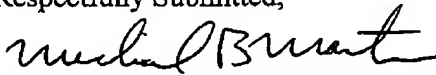
Further in this regard, Applicant respectfully points out that the only polymers prepared and tested in Baroche are behenyl acrylate homopolymer (Examples 1, 2 and 4) and behenyl acrylate-N-vinyl pyrrolidone copolymer (Example 3). In this regard, see Applicant's Examples 9 and 10 which compare the rheological performance and paraffin inhibition of polymers such as those described by Baroche (Polymers 1-4, especially polymer 1) and polymers according to this invention (Polymers 5-10). Applicant respectfully asserts that these results are not taught or suggested by Baloche. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1-12, 14-15 and 17-28 are rejected under 35 U.S.C. § 103(a) over Baloche.

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**OFFICIAL****CONCLUSION**

In view of the foregoing amendment and remarks, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. §§ 103(a) and 112, second paragraph and respectfully assert that this application is in condition for allowance. Early notice to this effect is earnestly solicited.

Respectfully Submitted,



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